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10/712,280	11/12/2003	Patrick Guiney	11.037011 US	9311
41696	7590	08/21/2007	EXAMINER	
VISTA IP LAW GROUP LLP			HYUN, PAUL SANG HWA	
12930 Saratoga Avenue				
Suite D-2			ART UNIT	PAPER NUMBER
Saratoga, CA 95070			1743	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/712,280	GUINEY, PATRICK	
	Examiner Paul S. Hyun	Art Unit 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11 June 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-6,8-23,25-43 and 51-58 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-6,8-23,25-43 and 51-58 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

REMARKS

Claims 1-6, 8-23, 25-43 and 50-58 are currently pending. Claims 1, 2, 4, 11, 18, 21, 30, 39 and 51-55 were amended.

The Declaration filed under 37 CFR 1.131 has been acknowledged. The Declaration is sufficient to overcome the Morrison reference.

The claim objections cited in the previous Office action have been withdrawn in light of the amendments.

Despite the amendments, the rejections of claims **39-42** and **52-55** under 35 U.S.C. 112, second paragraph, are maintained.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims **39-42** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear how the claimed vial relates to the claimed invention because claim 39 does not positively recite that the claimed invention comprises a vial. The claim recites the vial via its relationship with the specimen, but the specimen is non-limiting because it is not a part of the claimed invention. Specifically, independent claim 18 recites that the claimed system comprises only a filter, a container, a data storage device, a processor and an interface. The claim does not recite that the sample is a part

of the invention. Because the sample is not a part of the claimed invention, limitations that are defined with respect to the sample are indefinite.

Claims 52-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims do not positively recite that the claimed apparatus comprises the slide processor (claims 52 and 53) or a vial (claim 54). Therefore, it is unclear whether the limitations directed towards the slide processor and the vial are limiting. Specifically, independent claim 51 recites that the invention comprises a filter and a data storage device. The claims do not recite that the invention comprises a slide processor or a vial. Therefore, limitations directed towards the slide processor and the vial do not further limit the claimed invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 11, 12, 14, 15, 18-23, 29-31, 33, 34 and 36-42 are rejected under 35 U.S.C. 102(b) as being anticipated by McDevitt et al. (US 2002/0045272 A1).

McDevitt et al. disclose an Analyte Detection Device (ADD) comprising a tray-like substrate having an array of wells (see Fig. 3), wherein each well can comprise a filter

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for processing blood samples (see [0464]). The ADD comprises a detector and a means for processing and producing data related to the analytes (see [0431]). The substrate can comprise a bar code for identifying the contents of the wells and relaying test protocols to a computer (see [0573], [0574]). The ADD may also be connected wirelessly, via a floppy drive, or a serial data connection to a network of computers to send and receive data (see [0438]).

With respect to claim 29, it is evident from Figure 64 of the reference that the ADD is positioned in a housing. Moreover, it is evident from the disclosure that the ADD comprises a processor. If the ADD did not comprise a processor, it would not be able to send and receive data.

With respect to claims 14 and 33, although the reference does not explicitly disclose that the bar code disclosed by McDevitt et al. relays the number of steps involved in the test protocols, it is evident that the bar code relays this information. If the bar code did not relay the number of steps involved in the test protocols, then the test could not be performed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 8-10 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDevitt et al. in view of Marsh et al. (US 5,219,294).

McDevitt et al. do not disclose the details of the connection between the ADD and a computer. However, it does disclose that the ADD can be connected to a computer system via well-known means (see [0438]).

Marsh et al. disclose a docking connector for connecting two electrical devices (e.g. computer and printer). The docking connector comprises a symmetrical recess comprising tapered surfaces 38a and 38b to ensure a solid physical connection (see Figs 1 and 6 and line 51, col. 3).

In light of the disclosure of Marsh et al., it would have been obvious to one of ordinary skill in the art to design the interface connection of the ADD disclosed by McDevitt et al. such that it can accommodate the connector disclosed by Marsh et al. so that the ADD can send and receive data from a computer. To accommodate the connector disclosed by Marsh et al., the ADD would need to comprise an interface having a symmetrical recess with tapered surfaces.

Claims 13 and 32 are rejected under U.S.C. 103(a) as being unpatentable over McDevitt et al. in view of Giordano et al. (US 5,935,426).

McDevitt et al. do not disclose that the data comprises the expiration of the filter.

Giordano et al. disclose a filter-based apparatus for filtering and treating water. The apparatus comprises a data storage unit 36 that stores data related to the filter, such as the expiration date of the filter (see lines 55-60, col. 13).

In light of the disclosure of Giordano et al., it would have been obvious to one of ordinary skill in the art to add the expiration date of the filter to the data storage means of the McDevitt et al. apparatus so that expired filters are not used for conducting experiments.

Claims 16, 17, 35, 43, 57 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDevitt et al.

With respect claims 16 and 35, it is well known in the art that most electronic products such as computers are assigned a universal product code or other forms of product identification number to facilitate the identification of the product. Therefore, it would have been obvious to assign a unique registration number to the data storage means of the ADD so that it can be easily identified in case that it has to be replaced.

With respect to claims 17 and 43, given that the ADD is intended to process blood samples, which contain blood cells, it would have been obvious to one of ordinary skill in the art to use a cytological filter.

With respect to claims 57 and 58, although the sample wells shown in Figure 3 is pyramidal, McDevitt et al. disclose that the shape of the sample wells can comprise other shapes (see [0121]). In light of the disclosure, it would have been obvious to one of ordinary skill in the art to make the wells and the filter cylindrical in shape to modify the filtering rate.

Claims 51-56 are rejected under U.S.C. 103(a) as being unpatentable over McDevitt et al. in view of Bailey et al. (US 5,468,968).

McDevitt et al. do not disclose that the bar code is located on the filter.

Bailey et al. disclose a filter-based apparatus for monitoring air quality. The apparatus comprises a plurality of filters wherein each filter comprises a bar code (see Abstract). The bar code is used to store filter-related data.

In light of the disclosure of Bailey et al., it would have been obvious to one of ordinary skill in the art to place a bar code on each filter of the McDevitt et al. apparatus to obviate confusion when each filter is used to process a different sample.

With respect to claim 56, given that the ADD disclosed by McDevitt et al. is intended to process blood samples, which contain blood cells, it would have been obvious to one of ordinary skill in the art to use a cytological filter.

Response to Arguments

- I. Applicant's arguments with respect to Bailey have been fully considered but they are moot. The amendments changed the scope of the claims and the reference is no longer applicable.
- II. Applicant's arguments with respect to McDevitt et al. have been fully considered. The amendments changed the scope of the claims and necessitated new grounds of rejections. Nonetheless, Applicant's arguments will be addressed because they're pertinent. Applicant provides three arguments:

- a) Applicant argues that McDevitt et al. do not disclose a data storage device attached to or positioned within the container. This argument is not persuasive because

McDevitt et al. explicitly disclose that a bar code is placed on the sensor array (see [0573]).

b) Applicant argues that the bar code disclosed by McDevitt et al. does not store data related to the filter. This argument is not persuasive because the scope of the limitation "related" recited in the claims is broad enough that the data stored in the McDevitt et al. bar code can be considered to be "related" to the filter. As conceded by Applicant and disclosed in [0573] of McDevitt et al., the bar code can be used to identify the type of sensor array, including the type of test being conducted and the identity of the analyte filtered by the sensor array. This information is related to the filter because the information implicitly conveys the type of filter used in the sensor array.

c) Applicant argues that the computer disclosed by McDevitt et al. is not within the scope of the claimed data storage device because the computer is not attached to the sensor array as recited in the claims. This argument is not persuasive because McDevitt et al. disclose that the sensor array may be connected to a computer via a serial data connection (see [0438]). It is evident from the disclosure and common knowledge that the sensor array and the computer are physically attached by the serial data connection (e.g. USB).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul S. Hyun whose telephone number is (571)-272-8559. The examiner can normally be reached on Monday-Friday 8AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PSH
8/10/07


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